UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,077	11/27/2001	Jeffry J. Grainger	020313-000710US	1100

20350	7590	07/14/2006

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EXAMINER
MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Advisory Action ***Before the Filing of an Appeal Brief***	09/996,077	GRAINGER, JEFFRY J.
	Examiner	Art Unit	
	Janice A. Mooneyham	3629	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>05 July 2006</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ They raise the issue of new matter (see NOTE below);

   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

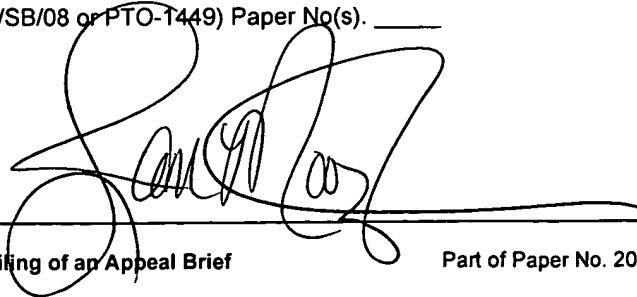   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>see below.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.

13. ☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-303 (Rev. 7-05)   Advisory Action Before the Filing of an Appeal Brief   Part of Paper No. 20060711

he Examiner has fully reviewed and considered the applicant's request for reconsideration but does not find it persuasive.

The applicant asserts that to esablish a prima facie case of obviousness, the Office action must establish a teaching or suggestion in the cited prior art of each claimed limitation. The applicant argues that none of the references, alone or in combination, teach or suggest a workflow rule of executing the workflow rule to generate a message requesting approval to prepare a patent application from an invention disclosure.
The applicant argues that Takano does not teach a workflow rule.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Serbinis, Takano and Gross disclose document preparation by the transmission and reception of data via a server computer (Takano col. 2, lines 3-10; Serbinis col. 5, lines 4-15). The Examiner asserts that the combination of Takano, Serbinis and Gross are analogous art since they are in the field of appellant's endeavor and are reasonably pertinent to the particular problem with which the appellant is concerned. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Takano discloses a system and method for preparing patent specifications for patent applications (col. 1, lines 8-18).
Serbinis discloses workflow information with an Internet accessible server programmed to provide a plurality of document management services including workflow, wherein a client system is allowed to set up workflow rules that define, for predetermined events, selected client systems for the server system to send messages (Figure 2 (61), col. 2, lines 52-57 Internet based document management system and method that permit users to access a plurality of services supported by a common Internet-based database, including document storage, collaborative file sharing and workflow, document delivery and distribution; col. 10, lines 23-34) and a database for storing the documents (col. 5, lines 26-35 database 25, which may be a relational database, stores data concerning documents controlled by server computer and stored in store 30; col. 4,lines 16-28; col. 5, line 63 thru col. 6, line 1 Notification server 35; col. 6, line 64 thru col. 7, line 3 Notification information tables; col. 10, lines 23-34).

Takano discloses a notification means (col. 12, lines 55-64) and Serbinis discloses a notification means (col. 6, line 64 thru col. 7, line 3).

Takano discloses requesting approval to prepare a patent application from an invention disclosure (col. 15, lines 12-18 If the patent-application-filing persons, having referenced the gazette data and the draft data for the specification for patent application, judge that the contents of the draft data are neither novel nor unobvious, and notify the inventor using the client computer 100, by electronic mail with the notifying means 204, of a decision not to file an application for the pertinent piece of invention report information.)

The applicant argues that Serbinis does not teach or suggest a workflow rule, only a table or list of tasks and that the table cannot be executed.
Applicant describes the workflow process in paragraphs [0052-0054].

Serbinis discloses a workflow service (rule) in which a workflow table may be associated with a document in DMS database that specifies multiple tasks to be performed in sequence (workflow rule) by the Authorized Users. The Originator may associate or import a series of task descriptions stored in DMS database with a document and a list of Authorized Users responsible for performing those tasks. After an Authorized User retrieves the document, performs the task assigned to him or her and returns the document to store, notification server generates and sends an appropriate notification to the Authorized user responsible for the next task in the workflow (col. 10, lines 23-34). Thus, Serbinis carries out or performs tasks according to instructions, thus executing a workflow rule.

The applicant argues that Gross does not teach or suggest a workflow rule nor executing the workflow rule to generate a message requesting approval to prepare a patent applicant from an invention disclosure. Gross was cited for the limitation of receiving a request to solicit comments and approval of a document (Figure 4 (112); col. 3, lines 59-62; col. 4, lines 43-47) and allowing for comments to be relayed upon viewing and/or proofing the document (col. 6, lines 49-52 upon viewing and/or proofing the document, the system allows the recipient or recipients to relay their comments and decision back to the server). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Thus, the Examiner asserts that the prior art does disclose storing a workflow rule on a server system and executing the workflow rule to generate a message. Furthermore, the applicant's assertion that all of the references teach sending email notifications base on a stored record or a table of users, not on an executed rule, is incorrect. Serbinis discloses a workflow service (rule) in which a workflow table may be associated with a document in DMS database that specifies multiple tasks to be performed in sequence (workflow rule) by the Authorized Users. The Originator may associate or import a series of task descriptions stored in DMS database with a document and a list of Authorized Users responsible for performing those tasks. After an Authorized User retrieves the document, performs the task assigned to him or her and returns the document to store, notification server generates and sends an appropriate notification to the Authorized user responsible for the next task in the workflow (col. 10, lines 23-34).